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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,292	05/31/2000	Cary Lee Bates	ROC920000067	3183
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Gero G McClellan Thomason Moser & Patterson LLP 3040 Post Oak Boulevard Suite 1500 Houston, TX 77056-6582				
EXAMINER				
WON, YOUNG N				
ART UNIT		PAPER NUMBER		
2155		4		
DATE MAILED: 12/23/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/584,292

Applicant(s)

BATES ET AL.

Examiner

Young N Won

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-24 and new claims 25-27 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vajk et al. (US 5265033 A) in view Edmonds et al. (US 4866668 A).

Independent:

As per claims 1, 15, and 18, Vajk teaches a method, an apparatus, and a computer readable medium comprising software that, when executed by a general-purpose computer, causes said general-purpose computer to perform a method, for providing an electronic mail distribution process comprising: creating an electronic mail message (see col.6, lines 52-55 and col.13, lines 55-57) having a flag to identify the electronic mail message (see col.17, line 64 to col.18, line 1); and forwarding a received electronic mail message to recipients in a recipients list (see col.7, lines 13-17 and col.23, lines 6-13). Vajk does not explicitly teach that the electronic mail message is a

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cascade-type message. Edmonds teaches of a cascade-type message (see col.5, lines 14-18 and col.7, lines 6-23). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Edmonds within the system of Vajk by implementing a cascade-type message within the electronic mail distribution method, apparatus, and program because Edmonds teaches that cascading orders a destination control element, having received a packet in memory, to transmit to memories of other control elements, thereby controlling the delivery of messages, and because Vajk teaches that "other special types of messages" can be employed (see col.16, lines 14-16).

As per claim 3, Vajk teaches a method for providing a cascade electronic mail distribution process comprising: creating a first electronic mail message (see col.6, lines 52-55 and col.13, lines 55-57); distributing the first electronic mail message to at least one first recipient; forwarding the first electronic mail message from the at least one first recipient to at least one second recipient (see col.7, lines 13-17 and col.23, lines 6-13); and creating a forwarded mail log that identifies the first electronic mail message and the recipients of the first electronic mail message (see col.11, lines 23-28 and col.18, lines 49-56). Vajk does not teach wherein the electronic mail message is a cascade-type message. Edmonds teaches of a cascade-type message (see col.5, lines 14-18 and col.7, lines 6-23). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Edmonds within the system of Vajk by implementing a cascade-type message within the electronic mail distribution method, apparatus, and program because Edmonds teaches that cascading

orders a destination control element, having received a packet in memory, to transmit to memories of other control elements, thereby controlling the delivery of messages, and because Vajk teaches that "other special types of messages" can be employed (see col.16, lines 14-16).

As per claim 8, Vajk teaches of an apparatus (see col.32, lines 59-61) for providing cascade electronic mail distribution comprising: a first terminal for sending electronic mail message through a network; a second terminal for receiving from the first terminal via the network the electronic mail message, updating a forwarded log with an identification of a third terminal, and forwarding the electronic mail message to the third terminal. Vajk does not teach wherein the electronic mail message is a cascade-type message. Edmonds teaches of a cascade-type message (see col.5, lines 14-18 and col.7, lines 6-23). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Edmonds within the system of Vajk by implementing a cascade-type message within the electronic mail distribution method, apparatus, and program because Edmonds teaches that cascading orders a destination control element, having received a packet in memory, to transmit to memories of other control elements, thereby controlling the delivery of messages, and because Vajk teaches that "other special types of messages" can be employed (see col.16, lines 14-16).

As per claim 20, Vajk teaches of a computer readable medium (see col.15, lines 5-10) comprising a data structure of an electronic mail message comprising: message identification; a recipient's field; a message type field that identifies a cascade feature of

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the electronic mail message; and a message field (see col.8, lines 39-47). Vajk does not expressly show the electronic mail comprises: message field, recipient field, message identification, or message type. However, these differences are only found in nonfunctional descriptive material and are not functionally involved in the steps recited. The electronic mail message will “encode” and “include” information for providing the message service control function regardless of the data. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to “encode” and “include” any type of data or content because such data does not functionally relate to the step claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Vajk does not teach about a cascade feature. Edmonds teaches of a cascade-type message (see col.5, lines 14-18 and col.7, lines 6-23). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Edmonds within the system of Vajk by implementing a cascade-type message within the electronic mail distribution method, apparatus, and program because Edmonds teaches that cascading orders a destination control element, having received a packet in memory, to transmit to memories of other control elements, thereby controlling the delivery of messages, and because Vajk teaches that “other special types of messages” can be employed (see col.16, lines 14-16).

As per claim 27, Vajk teaches of a method for providing a cascading electronic mail distribution process comprising: receiving, from the sender, a first identified electronic mail message (see col.6, lines 9-12); forwarding, in response to a prompt from a user, the first electronic mail message to at least one recipient (see abstract); receiving from the sender, a second identified electronic mail message (see col.6, lines 9-12); and automatically forwarding (see col.27, lines 46-48) the second electronic mail message to the at least one recipient as a result of the first and second electronic mail messages being identified being from the same sender (It is inherent that if any email is identified by the user to be forwarded, such action will occur).

Dependent:

As per claims 2, 16, and 19 Vajk teaches of further comprising: creating an electronic mail message having a flag to identify the electronic mail message (see col.18, lines 51-56 and col.30, lines 1-5); and automatically forwarding a received electronic mail message to recipients in a forwarded mail log (see col.20, lines 58-62 and col.27, lines 46-49). Vajk does not explicitly teach that the electronic mail has is a cascade forward-type. Edmonds teaches of a cascade forward-type message (see claims 1, 15, and 18 rejection above).

As per claim 4, Vajk teaches of further comprising: identifying the at least one second recipient in a recipient table (see col.15, lines 19-29), where the at least one second recipient is cascade enabled (see col.15, lines 44-51 and col.20, line 67 to col.21, line 2).

As per claim 5, Vajk teaches of further comprising: creating a second electronic mail message that is required to be received by all the recipients of the first electronic mail message, where the second electronic mail message is a cascade forward type message; distributing the second electronic mail message to the at least one first recipient; accessing the forwarded mail log to identify the at least one second recipient that received the first electronic mail message; automatically forwarding the second electronic mail message to the identified at least one second recipient (see claim 2 and 3 rejection above). Vajk teaches of creating, distributing, accessing, and auto-forwarding of electronic mail messages, therefore, the number of times these steps are performed or the order of performance does not constitute an invention.

As per claim 7, Vajk teaches of further comprising: identifying if a user accepts cascade-type electronic mail and, if not, sending an electronic message to the sender of a cascade-type electronic mail message that identifies the user as not accepting cascade-type electronic mail (see col.18, lines 30-32 & line 63 to col.19, line 15).

As per claim 9, Vajk further teaches wherein the forwarded cascade-type electronic mail message comprises an original message from said first terminal and additional message information from said second terminal (see col.15, lines 46-51).

As per claim 10, Vajk further teaches wherein the cascade-type electronic mail message comprises: message identification; a recipient's field; a message type field that identifies a cascade feature of the electronic mail message; and a message field (see claim 20 rejection above).

As per claims 11 and 21, Vajk further teaches wherein the message identification comprises a user name and a time-stamp (see col.8, lines 39-47 and col.29, lines 56-68).

As per claims 12, 13, 22, and 23, Vajk further teaches about the message type field (see col.18, lines 30-32 and col.29, lines 56-62). Vajk does not teach about cascade. Edmonds teaches about cascade (see claim 8 rejection above).

As per claims 14 and 24, Vajk teaches of further comprising a previous message field (see col.15, lines 46-51).

As per claim 25, Vajk further teaches wherein the received cascade-type (see claim 1 rejection above) electronic mail message is addressed to the recipient (see col.15, lines 18-19) and wherein the flag prompts an email program to automatically forward (see col.27, lines 46-48) an email message to the recipients if the email message is received by the recipient after forwarding the received cascade-type electronic mail (see col.6, lines 9-12).

As per claim 26, Vajk further teaches wherein the forwarded mail log is populated with the recipients in the recipients list at the time of forwarding (see abstract: "store and forward").

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vajk et al. (US 5265033 A) and Edmonds et al. (US 4866668 A), and further in view of Doyle (US 6356886 B1).

As per claim 17, Vajk and Edmonds do not explicitly teach wherein the cascade forward-type electronic mail message comprises a retraction of a previously sent electronic mail message. Doyle teaches of retracting a previously sent message (see col.5, lines 42-43). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Doyle within the system of Vajk and Edmonds by implementing a retraction of a previously sent message within the electronic mail distribution method, apparatus, and program because this would allow for a mistake in transmission to be rescinded such that the receiving node will not be able to view the message which may contain confidential or secure information.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 6 recites the limitation "said accessing step" in page 12, line 9 of the disclosure. There is insufficient antecedent basis for this limitation in the claim. Claim 6, depends on claim 1 and 4 and there is not prior mention of an accessing step in either claim 1 or claim 4.

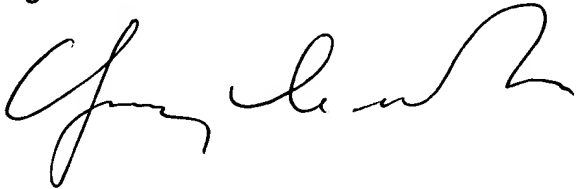
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Young N Won



December 16, 2003



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER